REMARKS

Claim 42 has been amended as discussed at the interviews. The deletion of subpart (d) of claim 42, of course, is not problematic. The amendment to part (a) is believed to conform the limitations of claim 42 to those suggested by the written description guidelines, which the Federal Circuit commented favorably on in *Enzo Biochem. v. Gen-Probe*, 323 F3d 956, 63 USPQ 2d 1609 (Fed. Cir. 2002). Although it was requested that 95% identity be substituted for 90%, no *in haec verba* support could be found in the specification. However, the figure of 90% is supported at page 27, line 27 of the specification and claim 2 as originally filed. The limitation to limit the substitutions to conservative amino acids is supported at page 28, line 6 and the nature of conservative amino acid substitutions is described at page 28 in the same paragraph. Accordingly, no new matter has been added and entry of the amendment is requested. The dependent claims have been amended to conform to the amendment of claim 42.

Some concern was expressed in a telephone conversation with Examiner Joyce that perhaps subparts (b) and (c) of claim 42 read on cDNA that encodes only fragments of the protein. This is not applicants' intent, and if the Office feels it necessary, an Examiner's amendment is authorized to change "encodes a protein" in each case to "encodes a full-length protein".

Though these amendments are made after final, in view of the discussion at the interviews and the attempt to place the claims in a position for allowance thereby, entry of these amendments is respectfully requested.

Before addressing the rejections of record, applicants note that it was requested at the first interview that evidence of the presence of the protein encoded by the nucleic acids in cancer tissue specimens be submitted. Such evidence was submitted in the parent application U.S. 09/547,789 in the form of a declaration of Dr. Pia M. Challita-Eid. This declaration is now enclosed and made of record in the present case. This declaration confirms that the protein is indeed present both in ovarian and prostate cancer.

Turning to the outstanding grounds for rejection, the rejection of claims 42-51 under 35 U.S.C. § 112, paragraph 2, has been obviated by amendment, by deleting subpart (d) of the claim as previously presented.

The Rejections Under 35 U.S.C. § 112, Paragraph 1

Claims 42, 45-46 and 49-51 were rejected on the basis that no declaration was supplied verifying the conditions of deposit. Applicants hereby verify that the deposits of ATCC Nos. 207084 and 207129 were made under the conditions of the Budapest Treaty. Further, as the parent application has issued as a patent, all restrictions on the availability to the public of the deposited material have been irrevocably removed. It will be noted that the date of deposit and the name and address of depository appear in the specification of the issued patent in column 41, beginning at line 16, and appear in the present application on page 69 at lines 9-13.

The rejection in paragraph 6 of the Office action of claims 42, 47 and 49-51 with regard to enablement is believed obviated by the amendment to the claims.

In paragraph 7 of the Office action, claims 42-43, 47 and 49-51 were rejected as lacking written description. It is believed this basis for rejection may be withdrawn in view of the amendment to the claims to specify the functional limitation that the encoded protein raises antibodies that bind an extracellular region of the protein consisting of the amino acid sequence of SEQ ID NO: 2. This is clearly a functional limitation that brings the encoded protein within the framework of the PTO Guidelines. It is believed that this was agreed upon at the second interview. Thus, this rejection, too, may be withdrawn.

The rejection of paragraph 8 of the Office action, applied to all claims, is also moot in view of the amendment to the claims.

Summary

In view of the foregoing amendment, the discussion at the interviews, and the discussions above, it is believed that the pending claims, claims 42-46 and 48-51 are in a position for allowance and passage of these claims to issue is respectfully requested. Applicants again thank Examiners Joyce, Ungar, and Eyler for their consideration.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **511582001111**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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